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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/368,503 08/05/99 JONES

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EXAMINER

BATSON, V

ART UNIT

PAPER NUMBER

3671

DATE MAILED:

08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/368,503</b>	Applicant(s) <b>JONES ET AL.</b>
	Examiner <b>VICTOR BATSON</b>	Group Art Unit <b>3671</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-72 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-54, 62-66, 71, and 72 is/are allowed.

Claim(s) 55-61 and 67-70 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 9,10

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Copy of Patent***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Claim Objections***

2. Claim 65 is objected to because of the following informalities: In claim 65 line 1, it appears that "which" should be inserted after "in". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. Claims 67-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 67 line 4, "the coupling" lacks proper antecedent basis. In claim 68 lines 2 & 3, "the body" and "the bore" lack proper antecedent basis. In claim 69 line 1, "the body" lacks proper antecedent basis.

***Recapture***

Claims 55-61 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re*

*Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Recapture exists because the limitation of a the lock being **rigid** and the lock having a face adapted to oppose **and engage** the rear bearing face were added to original claim 1 to define over the prior art of record but have been omitted in the broadened claim limitations of claims 55 & 59 in the reissue.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 67 & 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (4,433,496).

Jones et al. discloses a lock having all of applicant's claimed structure including a opposite front 36 and rear (considered the area of C-clamp 26 that opposes areas 20 & 21) bearing faces wherein the front face is adapted to oppose the boss (considered the mounting area of lip 10), and the rear face is adapted to oppose the wear member 16 to maintain the coupling of the wear member to the boss, with an adjustment assembly 33 for selectively varying the relative positions of the front and rear bearing faces. Jones et al. further discloses a projection (considered the top & bottom outer sections of the C-clamp 26) that cooperate with a keeper structure (considered faces 24 & 25) to hold the lock in the opening in the wear member as shown in figure 1.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5,088,214) in view of Jones et al. (4,433,496).

Jones '214 discloses a wear assembly including a boss 29, having a T-shaped structure, a wear member with a T-shaped coupling structure releasably coupled to the T-shaped structure of the boss, with an opening extending therethrough, and a lock having a first and second face, received into the opening to hold the wear member to the boss. Jones '214 however lacks the lock including an adjustment assembly selectively movable to vary the relative positions of the first and second faces.

Jones '496 teaches that it is known in the art for a lock to be selectively movable. A selectively movable or adjustable lock allows the lock to be adjusted to compensate for wear which can cause looseness in the entire wear assembly.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made, to modify the lock of Jones '214 so that the first and second faces can be selectively movable as taught by Jones '496.

***Allowable Subject Matter***

8. Claims 1-54, 62-66, 71, 72 are allowed.
9. Claims 68 & 70 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in

this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record discloses various wear assemblies.

**Inquiries**

11. Any inquiry concerning this communication should be directed to Examiner Victor Batson whose telephone number is (703) 305-6356. The examiner can be normally reached Monday through Friday (except Wednesday) from 7:00 am to 5:00 pm, Eastern Standard Time.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-3597.

July 25, 2000

Victor Batson  
Primary Examiner  
Art Unit 3671